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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,180	02/25/2004	Thomas Birkhoelzer	32860-000704/US	3381
30593 7590 04/14/2008 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195				
EXAMINER SHAN, APRIL YING				
ART UNIT 2135		PAPER NUMBER		
MAIL DATE 04/14/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,180

Applicant(s)

BIRKHOELZER ET AL.

Examiner

APRIL Y. SHAN

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 January 2008 has been entered.
2. Claims 1, 8, 22 and 31 have been amended. No new claims have been added. Claims 1- 32 are currently pending in the present application.
3. Applicant's amendments and argument have been respectfully and fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments.
4. Any objection/rejections not repeated below for record are withdrawn due to Applicant's amendment.

Information Disclosure Statement

5. The information disclosure statement filed 9 April 2007 fails to comply with 37 CFR 1.98(a)(3) because German Office action does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

6. Applicant is advised that should: Claims 1 and 22, claims 8 and 31 be found allowable, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 14 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per **claims 14 and 23**, while the preamble recites "A storage medium, adapted to store information and adapted to interact with a data processing facility...", the claimed stored information and storage medium do not define any structural and functional interrelationships between the stored information and other claimed elements of a computer which permits the stored information functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer programs functionality to be realized, and is thus statutory. See Lowry, 32F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Claim Rejections - 35 USC § 103

9 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl et al. (U.S. Patent No. 6,031,910) in view of Beaver et al. (U.S. Patent No. 7,234,059)

As per **claims 1 and 8**, Deindl et al. discloses a method/facility, comprising:

performing a security check to ascertain an identity of a user ("authorizing a user assigned to a user group by means of an identification feature" – e.g. col. 6, lines 22 – 23 and e.g. col. 6, lines 33-43.

Please note authorizing a user corresponds to Applicant's performing a security check);

the data key being unviewable by the user ("generating one or more cryptographic keys in the chip card for use by a computer...encrypting at least one of cryptographic keys in the chip card with a second cryptographic key..." – e.g. col. 6, lines, 23-32. Please note the one or more cryptographic keys reside on the chip card and encrypted. Therefore, the keys are unviewable by the user); and the data key being for at least one of encrypting and decrypting data ("encrypting at least one set of data by means of the cryptographic keys in the computer" - e.g. col. 6, lines 26-28).

Deindl et al. does not expressly disclose associating the user with a user group including a plurality of users such that ~~assigning~~ a data key is assigned to the user based on the user group with which the user is associated, and the same key [is] being assignable to [a] the plurality of users.

Beaver et al. discloses disclose associating the user with a user group including a plurality of users such that ~~assigning~~ a data key is assigned to the user based on the user group with which the user is associated, and the same key [is] being assignable to [a] the plurality of users ("...If the users are supposed to be members of a distinguished group, then authentication is necessary to avoid use by non-members...One way to provide authentication is to have all the group members share a common piece of information...For example, the users could share a symmetric encryption/decryption key..." – e.g. col. 2, lines 4-27).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Beaver et al.'s associating the user with a user group including a plurality of users such that a data key is assigned to the user based on the user group with which the user is associated, and the same

key [is] being assignable to [a] the plurality of users with Deindl et al. motivated by "this scheme preserves anonymity: as long as all group members use the same key, no one knows which member encrypted the message. Furthermore, it provides data integrity because if a message has been altered since it was sent, it will not decrypt properly" (e.g. col. 2, lines 23-27 of Beaver et al.)

As per **claims 2 and 9**, Deindl et al. - Beaver et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the security check involves checking biometric data of the user (e.g. col. 6, lines 33-43).

As per **claims 3 and 10**, Deindl et al.- Beaver et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the security check involves checking a user-specific at least one of electronic and mechanical key ("In reading a file the doctor must be in possession of a user card 310. The user card 310 legitimizes the doctor as an authorized doctor in a particular specialty – e.g. col. 4, lines 53 –55 and col. 7, lines 57-63. Please note a doctor's user card corresponds to Applicant's a user-specific at least one of electronic and mechanical key).

As per **claims 4-5 and 11-12**, Deindl et al. - Beaver et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the data key is ascertained by comparing the data obtained in the security check with content of a data key memory and wherein the data obtained in the security check are compared with the content of the data key memory using a data telecommunication device (e.g. col. 4, lines 26-36 and col. 4, lines 53-67).

As per **claim 6**, Deindl et al. - Beaver et al. discloses a method as applied above in claim 1. Deindl et al. further discloses wherein a plurality of data keys are simultaneously assignable to one user (e.g. col. 6, lines 23-25).

As per **claims 7 and 13**, Deindl et al. - Beaver et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the data are medically relevant, wherein the users include personnel at a medical facility, and wherein common user groups are assigned the same data key (e.g. col. 7, lines 57-63).

As per **claim 14**, Deindl et al. - Beaver et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Deindl et al. discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per **claim 32**, Deindl et al. - Beaver et al. discloses a method as applied above in claim 1. Deindl et al. further discloses wherein users associated with a common user group are assigned the same data key (e.g. col. 7, lines 57-63 and see the above rationale in rejecting claim 1 above).

As per **claims 15 and 20**, they are rejected using the same rationale as rejecting claim 3 above.

As per **claims 16-17**, they are rejected using the same rationale as rejecting claim 4 above.

As per **claims 18-19**, they are rejected using the same rationale as rejecting claim 5 above.

As per **claim 21**, it is rejected using the same rationale as rejecting claim 11 above.

As per **claims 22 and 31**, they are rejected using the same rationale as rejecting claims 1 and 8 above.

As per **claim 23**, Deindl et al. - Beaver et al. discloses the claimed method of steps as applied above in claim 22. Therefore, Deindl et al. - Beaver et al. discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per **claim 24**, it is rejected using the same rationale as rejecting claim 2 above.

As per **claim 25**, it is rejected using the same rationale as rejecting claim 3 above.

As per **claim 26**, it is rejected using the same rationale as rejecting claim 4 above.

As per **claim 27**, it is rejected using the same rationale as rejecting claim 5 above.

As per **claim 28**, it is rejected using the same rationale as rejecting claim 6 above.

As per **claim 29**, it is rejected using the same rationale as rejecting claim 7 above.

As per **claim 30**, it is rejected using the same rationale as rejecting claim 32 above.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
(See PTO - 892)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2135
/KIMYEN VU/
Supervisory Patent Examiner, Art Unit 2135